

Docket No. 220032001301(94-1DIV2CON2)
PATENTREMARKS

Claims 94, 96-121, 124, 127-170 are now pending in the above-referenced patent application. Of these, claims 94, 96-103, 106, 107, 112, 115, 116, 121, 127, 129-145, 151, 152, 158 and 163 have been considered on the merits. Claims 104, 105, 108-111, 113, 114, 117-120, 128, 146-150, 153-157 and 159-162 have been withdrawn from consideration as being drawn to a non-elected species. Applicants respectfully request further consideration of the claims, in view of the amendments set forth above and the following remarks in this Supplemental Amendment D, considered together with the remarks previously-submitted in Amendment C.

Examiner Interview

Applicants thank the Examiner for the courtesy of an interview on October 29, 2003, during which the specification, the then-pending claims, and the prior art were discussed. In particular, the issues presented in the last Office action and the previously-submitted Amendment C were discussed.

The Examiner indicated that the written description rejection of all examined claims (under paragraph 7 of the Office action) would be withdrawn in view of the arguments presented in Amendment C.

The Examiner also agreed to withdraw the prior art rejections (under paragraph 13 of the Office action) in view of the amendments to independent claims 94, 121, 124 and 135 as presented in this Supplemental Amendment D.

The new matter rejection of claim 163 (under paragraph 6 of the Office action) was discussed, and it was contemplated that this basis for rejection would be obviated in view of the amendments presented in this Supplemental Amendment D, subject to the Examiner's further review of these amendments and consideration of the related comments already of record in Amendment C.

The enablement rejection (under paragraph 8 of the Office action) was also discussed, including in particular, Applicants position as set forth in the previously-filed Amendment C and as supplemented herein.

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The specification has been amended to change the title to more closely relate to the subject matter of the present invention. No new matter has been added.

Cancelled Claims

Claims 95, 122, 123, 125 and 126 have been cancelled solely to advance the prosecution of the instant case. Applicants expressly reserve the right to refile the cancelled claims, without prejudice, in a continuing application. Applicants' cancellation of these claims should not, in any way, be considered as an admission with respect to any outstanding rejections applying to such claims, and Applicants hereby expressly deny any such interpretation. Likewise, Applicants cancellation of these claims should not, in any way, be considered as a surrender of any subject matter covered by the cancelled claims or any equivalents thereof, and Applicants hereby express their intent to pursue patent coverage for such subject matter and equivalents thereof.

Amended Claims

Claims 94, 121, 124 and 135 have been amended to advance the prosecution of this case and to claim a preferred embodiment of the invention in which the non-biological organic polymers are co-polymers or higher-ordered polymers (*e.g.*, terpolymers, *etc.*). Claim 129 has been similarly amended, without narrowing the substantive scope thereof. Support for these amendments can be found in the specification and in previously-pending claims 95, 123 and 126, each now cancelled.

No new matter has been added.

Rejections Under 35 U.S.C. § 112 (Enablement)

As noted in the previously-submitted Amendment C, the Office action has rejected each of the considered claims as being non-enabled by the specification. Specifically, it is alleged that one skilled in the art would not have been able to make and/or use the invention as claimed without undue experimentation. (See paragraph 8 at pages 5-8 of the Office action).

Applicants respectfully traverse these grounds of rejection, in view of the remarks already of record in Amendment C, supplemented herein as follows.

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Briefly, as summarized on pages 23-26 of the previously-submitted Amendment C, Applicants believe that the invention is fully enabled by the specification, particularly when appropriate consideration is given to the *nature of the invention* – here relating to a particular protocol involving a substrate-based format for preparing and screening arrays of non-biological organic polymers. It is particularly relevant, in this regard, that (i) *known* polymerization techniques can be used to practice the invention, (ii) the *state of the art* for polymerization is well developed, and (iii) the *level of skill* in the art is high. It is also highly relevant that the specification provides *substantial guidance* relating to the particular aspects and techniques that relate to the particular format, that is, the particular *nature of the invention*, that Applicants are claiming. The Applicants respectfully request the Examiner to reconsider her position in view of the detailed remarks in Amendment C, as supplemented herein.

Equivalents

The amendments to the claims and the arguments presented in supplemental response to the Office action have been made to claim subject matter which the Applicants regard as their invention. By such amendments, the Applicants in no way intend to surrender any range of equivalents beyond that which is needed to patentably distinguish the claimed invention as a whole over the prior art. Applicants expressly reserve patent coverage to all such equivalents that may fall in the range between applicants literal claim recitations and those combinations that would have been obvious in view of the prior art. In particular, as noted above, claim 129 has not been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705 (2002), and Applicants are therefore entitled to the full range of equivalents with respect thereto.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants believe that no further amendments are required in connection with this Supplemental Amendment D. If necessary however, the Examiner is also authorized to debit any

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necessary fees for this amendment, or any other fees required in connection with this application,
or to credit any overpayment of fees in connection with this application to Deposit Account No.
50-0496.

Respectfully submitted,



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